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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,042	03/01/2004	Robert M. Best	493-042-03	1267

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EXAMINER	
MOSSER, ROBERT E	

ART UNIT	PAPER NUMBER
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/791,042	BEST, ROBERT M.	
	Examiner	Art Unit	
	Robert Mosser	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-21 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 3/01/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

Claims **1-21** of this application conflict with the pending claims of Applications No 10/668940, 10/782043, 10/794631, 10803385, 10/875664, 10/98773, 11/004217, 11/039768, and 11/039768. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **1-21** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the pending claims of

copending Applications No. 10/668940, 10/782043, 10/794631, 10803385, 10/875664, 10/98773, 11/004217, 11/039768, and 11/039768. Although the conflicting claims are not identical, they are not patentably distinct from each other because the cited Applications included elements directed to a multiplayer game system, including a player input device, the utilization of a three-dimensional environment including the control of player characters, composed of polygon elements, and a portable game device are commonly presented throughout the claims of co-pending applications.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

If the Applicant intends to maintain that these respective applications listed above are directed to distinct inventions they are requested to provide a table including at least the Application numbers as presented above, and the claim features presented in each respective application that serve to provide a distinction between each respective application and the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims **1-8,** and **10-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoi (US 5,682,171) in view of Nishiumi et al (US 5,903,257) in yet further view of Sasaki (US, 5,577,960).

Yokoi teaches a portable game system including:

a housing arranged to be held in a player's hands during use (*Yokoi* Figure 1, Element 6);

a first and second discrete display device in said housing (*Yokoi* Figure 4);

a central processing unit and a secondary graphics processing unit (*Yokoi* Elements 221, 223);

a optically code disk or semiconductor media for storing the game program (*Yokoi* Col 8:25-34);

at least one control device in said housing unit manually operated by a player (Element 6); and

a display device incorporation a stereoscopic display (*Yokoi* Abstract, Col 1:27-41).

In addition to the above Yokoi, is arguably silent regarding the inclusion of a player control structure operable to vary degrees according to the movement of a joystick element. In a related gaming invention Nishiumi teaches the inclusion player

control structure operable to vary degrees according to the movement of a joystick element (*Nishiumi* Figure 33, Col 9:31-66). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the control structure of Nishiumi into the invention of Yokoi to incorporate a known control structure capable of interpreting both a desired direction and magnitude of user input signals.

As presented the invention of Yokoi/Nishiumi teaches the incorporation of a three dimensional environment however is silent regarding the utilization of a game world and objects incorporating texture mapped polygon technology. In a related game invention Sasaki teaches utilization of polygon images to create game worlds and environments in player controlled worlds. It therefore would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the polygon mapping to create game images as set forth by Sasaki into the invention of Yokoi/Nishiumi in order to present images of higher quality while reducing the apparatus memory required to display the image as taught by Sasaki (Sasaki Col 5:10-16).

Claim limitations directed to the use of a player's thumb in effecting the operation of the apparatus define intended use of an apparatus and accordingly do not measurably affect patentably weight in the presented apparatus type claims.

Claim limitations directed to a "touch sensitive" type of input device are understood as presently being taught by a the joystick included in the combination as presented above.

If the Applicant intends for this limitation to encompass a capacitive touch sensor those limitations should be clarified within the claim language as presented.

Claim limitations directed to a "variable viewpoint" are understood as being demonstrated By Sasaki's figure 5.

Claim **9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoi (US 5,682,171) in view of Nishiumi et al (US 5,903,257) in yet further view of Sasaki (US, 5,577,960) as applied to at least claim **1**, above and further in view of Honda (US 6570563).

The combination of Yokoi/Nishiumi/Sasaki teaches the inclusion of a transfer port (*Yokoi* Elm 23) however the combination is silent regarding the communication with external gaming apparatus for the transfer of game related data. In a related gaming device however Honda teaches the incorporation of Internet works for creating multi-user environments including the exchange of data across multiple terminals (*Honda* Col 12:33-13-30, Figures 5-8). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the multiplayer features of Honda into the combination of Yokoi/Nishiumi/Sasaki in order to allow for user interaction in a multi-client environment.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RM/
June 20th, 2007